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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/186,810	11/05/98	CARLYLE	W S16.12-0052

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QM12/1217

EXAMINER

KISER, M

ART UNIT

PAPER NUMBER

3738

3

DATE MAILED:

12/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/186,810

Applicant(s)

Carlyle, et al

Examiner

Matthew Kiser

Group Art Unit

3738



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) 18-27 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-13 and 15-17 is/are rejected.

☒ Claim(s) 14 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restriction*

- I. Claims 1-17 , drawn to a arterial implant, classified in class 623, subclass 1
- II. Claims 18-27, drawn to method of making a prosthesis, classified in class 252, subclass 8.81.

1. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be made without cross-linking.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Peter Dardi on 12/5/99 a provisional election was made with traverse to prosecute the invention of I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-27 are withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,5-7,11-13,15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Weatherford, et al (*SURGERY* vol.120,2).

Claims 1,13,16: See entire document

Claims 5-7: See page 434

Claims 11,12,15: See Discussion (p. 435)

Claim 17: Inherent

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4,8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weatherford, et al (*SURGERY* vol.120,2) in view of Carpentier, et al (U.S. 4,648,881). Weatherford discloses the invention substantially as claimed. However, Weatherford does not disclose the use of glutaraldehyde (claims 2-4) nor does he disclose the use of porcine tissue (claims 8 and 10). Carpentier discloses the use of glutaraldehyde with porcine heart valves, for optimal tanning. Therefore it would have been obvious to one of ordinary skill in the art to incorporate the glutaraldehyde and porcine heart valve of Carpentier with the invention of Weatherford. Furthermore it is the opinion of the Examiner that it would be obvious to substitute human tissue for that of porcine. Weatherford even mentions human grafts (see discussion).

***Allowable Subject Matter***

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Kiser whose telephone number is (703) 306-5512. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:00 PM . The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Matthew Kiser

MBK

  
**Paul B. Prebille**  
**Primary Examiner**